

REMARKS

The present remarks are responsive to the Office Action mailed February 24, 2006, the shortened statutory response period having expired on May 24, 2006. Applicant submits herewith a three-month extension petition to reset the deadline for responding to the Office Action to and including August 24, 2006. In view of the following amendments and remarks, reconsideration of the Examiner's rejection and notice of allowance of all pending claims is respectfully requested.

Claims 1-18 and 25-30 are currently pending in the present application. Each of these claims was rejected in the outstanding Office Action under 35 U.S.C. § 103(a) in as being obvious in light of various combinations of the following art:

- U.S. Patent No. 6,064,855 issued to Ho ("Ho").
- U.S. Patent No. 4,884,974 issued to DeSmet ("DeSmet")
- U.S. Patent No. 6,167, 233 issued to Gresser, Jr. et al. ("Gresser")
- U.S. Patent No. 5,466,158 issued to Smith, III ("Smith")
- U.S. Patent No. 4,636,881 issued to Brefka et al. ("Brefka")

More specifically, claims 1-11 and 25-30 were rejected over *Ho* in view of *DeSmet*. Claim 12 was rejected over the combination of *Ho* and *DeSmet*, in further view of *Gresser*. Claims 13-15 were rejected over the combination of *Ho* and *DeSmet* in view of *Smith*. Finally, claims 16-18 were rejected over the combination of *Ho*, *DeSmet* and *Smith*, in further view of *Brefka*. As outlined above, each of these rejections is based at least on the combination of *Ho* and *DeSmet*.

Of claims 1-11 and 25-30 rejected over *Ho* in view of *DeSmet*, Applicant notes that claims 1, 6, and 25 are independent

claims, with the remainder of the rejected claims depending from one of the three. The Examiner contends that *Ho* teaches each of the claimed features of claims 1-11 and 25-30 with the exception of two, namely a controller/microprocessor and a book holder adapted to accept a ROM cartridge. Nevertheless, the Examiner contends that it would have been obvious to modify *Ho* to include a controller/microprocessor for controlling electrical functions and further that it would have been obvious to combine that fanciful creation with the teachings of *DeSmet*, which teaches a book holder adapted to accept a ROM cartridge. Applicant respectfully disagrees on both points.

First, adding a controller/microprocessor to the *Ho* invention is not merely an obvious expedient as the Examiner suggests. The book holder of *Ho* would have to be significantly modified and reengineered to utilize a controller/microprocessor. *Ho* teaches a circuit based system. If *Ho* were to be modified to include a controller/microprocessor, then the controller/microprocessor would necessarily need to include the logic required to determine which page was being read before seeking information for that page to be broadcast audibly. There is simply no teaching in *Ho* with regard to programming the logic necessary for this function, nor is there any suggestion toward that arrangement. In addition, it is not clear from the art that there would be a motivation to make such a substitution. In many respects, the *Ho* system as taught in the disclosure is a much simpler system than the controller/microprocessor based system proposed by the Examiner. The Examiner's position therefore appears to be a classic example of impermissible hindsight reconstruction, using the present invention as a roadmap. See, *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 26 U.S.P.Q.2d 1018 (Fed. Cir. 1993).

Second, the combination of the *Ho* (as modified) disclosure with that of *DeSmet* is not believed to be obvious. The Examiner contends that it would have been obvious to use the cartridge of *DeSmet* with the book holder of *Ho* (as modified) in order to have a more secure connection between the reader and memory. Applicant respectfully disagrees with this logic.

*Ho* already utilizes one or more memory chips formed within one or more book pages or in the back cover that communicate with the book holder through connectors. The Examiner suggests that selection of a book having a chip that is in contact with a reader or a separate cartridge in contact with a reader is a matter of design variation. This is simply untrue as the chips of *Ho* are connected to the pages that are being read or the back cover of the book, whereas the claimed cartridge requires both a cartridge and a cartridge slot which are both wholly absent in *Ho* (notwithstanding the presumption that the Examiner believes that it would have been an obvious addition). Further, the Examiner's suggestion that the cartridge of *Ho* provides a more secure connection between the reader and the memory card is believed to be misguided. *Ho*'s memory chips already provide a similar physical contact between the memory chip and the reader than the cartridge of *DeSmet* does. Applicant does not take this as an advantage sufficient to motivate one to use a cartridge rather than embedded chip(s). It is noted in this regard that the use of a cartridge complicates the system by requiring added elements. It also complicates the system in that one must be certain that the cartridge associated with the book being read is installed rather than a different cartridge. For young children or blind persons, both of which are in the *Ho* target audience (*Ho*, col. 6 11. 27-38), a simple device that incorporates the audio information directly into the book being read may be preferred.

For at least these reasons, claims 1-5 and claims 25-30 are believed to be allowable over the cited art.

With respect to claims 6-11, claim 6 is a method claim that, prior to this amendment, did not directly reference the reading controller anywhere other than in the preamble. Applicant has amended the "correlating" step of claim 6 to read "correlating with a reading controller said specified location. . . ." In this manner, it is believed that the arguments made above with respect to claims 1-5 and 25-30 are equally applicable to claims 6-11, and claims 6-11 are therefore believed to be allowable over the cited art.

It is also noted that claims 2-5, 7-11, and 26-30, which depend from claims 1, 6, and 25, respectively, are believed to include subject matter which is itself patentable beyond that of the subject matter from which each of these claims depends.

As previously discussed, claim 12 was rejected over the combination of *Ho* and *DeSmet*, in further view of *Gresser*. Claim 12 depends from claim 6, and therefore includes each of its features. As Applicant believes that claim 6 is allowable, claim 12 is likewise believed to be allowable. Notwithstanding, claim 12 is believed to include additional patentable subject matter as well.

Claims 13-15 were also rejected, as previously discussed. Of claims 13-15, claim 13 is independent, with claims 14 and 15 depending therefrom. Claim 13 generally add a book support surface adjoined to one side of the reading surface to the previously-discussed disclosure of claim 6. The Examiner contends that the combination of *Ho* and *DeSmet* in view of *Smith*, teach each of these features. Although the Examiner has made this contention and has stated that one would be motivated to combine the three references to provide a supporting structure for convenience of the user when reading the book, Applicant

suggests that this is yet another example of impermissible hindsight reconstruction, using the Applicant's disclosure as a template. The merits of a proposed combination of *Ho* and *DeSmet* have already been discussed above, and are applicable here with respect to claims 13-15. Further, the attempted addition of *Smith* to this fanciful combination also represents hindsight reconstruction, as there has been no indication by the Examiner of a motivation, suggestion, or teaching of the proposed combination within the references themselves.

The perceived hindsight reconstruction continues when one reviews claims 16-18, which the Examiner has rejected under the combination of *Ho*, *DeSmet*, and *Smith*, in further view of *Brefka*. "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 U.S.P.Q.2d 1321 (Fed. Cir. 1998). Further, where the technology behind an invention is particularly simple, as in the case here, the opportunity to judge by hindsight reconstruction is particularly tempting, and the tests of whether to combine references should be applied rigorously. *See, McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001); see also, *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000).

Applicant's comments made above with respect to the initial combination of *Ho* (as modified) and *DeSmet* apply equally with respect to claims 16-18. Even prior to the addition of two more levels of alleged obviousness, Applicant respectfully disagrees with the Examiner's position. For these reasons, claims 16-18 are believed to be allowable.

Finally, Applicant notes that the present application names only a single inventor. The Examiner's reference to an obligation under 37 CFR 1.56 to identify non-commonly owned

claims and certain inventor information related thereto is believed to be an oversight, and is not addressed substantively herein beyond this mention for purposes of responding to each point made by the Examiner for completeness.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: August 24, 2006

Respectfully submitted,

By   
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